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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,502	04/24/2006	Andreas Giefer	72187	1616
23872 7590 11/12/2009 MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227				
EXAMINER				
JOHNSON, PHILLIP A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,502

Applicant(s)

GIEFER ET AL.

Examiner

PHILLIP JOHNSON

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2009 has been entered.

Status of Claims

Claims 1 – 21 are pending in this application.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1 – 8 and 11 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami (USP 5,706,701) in view of Kim (USP 4,558,609).**

Murakami discloses (Fig. 1) all of the limitations of a similar device comprising:

- A housing structure (25).
- A selector lever (24), said selector lever having an upper portion.
- A hand knob (element 1 with constituent parts 4 and 5).
- A connection cable (Fig. 6; 6) comprising one or more lines.

- A switch (3).
- An adapter (Fig. 6; 9) mounted on said upper portion of said selector lever.
- Said adapter having an outer surface, said outer surface defining a recess (Fig. 6; 9d), wherein at least a portion of said one or more lines extends within said recess.
- Said adapter defining a connection between said selector lever and said hand knob (Fig. 5A).
- A shifting gate (26).

Murakami fails to disclose said adapter having said switch integrated therewith.

Kim (see Fig. 1 – 3), in a similar device, teaches an adapter (41) having a switch (assembly 50, 54) integrated therewith that reduces the assembly complexity, thereby improving serviceability over knobs with integrated switches.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Murakami to include an adapter having a switch integrated therewith, as taught by Kim, for the purpose of reducing assembly complexity, thereby improving serviceability.

Murakami as modified by Kim fails to disclose said adapter being located at a position above the shift gate.

As the applicant is silent to any unexpected results arriving from said adapter being located at a position above the shift gate, it would have been an obvious matter of design choice to have provided such an arrangement with Murakami as modified by Kim having said adapter being located at a position above the shift gate, and since it

appears that the prior art would perform perfectly well gate (*the adapter located above the would not have an impact of the adapter's function, since it merely serves to provide cable routing, positioning and retention assurance*) with said adapter being located at a position above the shift gate

Accordingly, the device of Murakami and Kim as modified above discloses said hand knob being connected to said upper portion of said selector lever via said adapter.

Re claim 2, the combination of Murakami and Kim as modified discloses said switch integrated in said adapter including a means (Murakami; Fig. 6 – element 6) for transmitting electrical and/or optical signals.

Re claim 3, the combination of Murakami and Kim as modified discloses said adaptor having a switch interface (Murakami; Fig. 6 - element 16) for a connection cable (15).

Re claim 4, the combination of Murakami and Kim as modified discloses wherein said at least said portion of said one or more lines being located adjacent to said exterior surface of said adapter, said hand knob surrounding said adapter, said adapter having a top outer surface, said top outer surface defining a switch recess, said switch being located in said switch recess, said adapter and said hand knob being located at a spaced location from said shift gate, said shift gate being located at a position below said hand knob.

Re claims 5, the combination of Murakami and Kim as modified discloses said adapter having a switch display part (Kim; Fig. 1 or 2 – top surface of push button 53).

Re claim 6, the combination of Murakami and Kim as modified discloses a switch display part, said switch display part being arranged opposite said switch (Kim, Fig. 1 or 2; top surface of push button 53 is arranged opposite button structure on which the top surface is disposed).

Re claim 7, the combination of Murakami and Kim discloses said adapter having at least one guide element (Murakami; Fig. 6 – vertical rib portions disposed between guides 9c) for positioning hand knob.

Re claim 8, the combination of Murakami and Kim discloses said adapter has a boring, into which said selector lever can be at least partially inserted (Murakami; Fig. 1).

Re claim 11, the combination of Murakami and Kim discloses said adapter has a plastic molding (Murakami; col. 4, lines 35 – 36: *“The skeleton frame 9 is preferably formed of electrical-insulating hard synthetic resin...”*), which is injection-molded on the selector lever via an injection molding process (*refers to a process of making a product and, therefore, has not been given any patentable weight. The patentability of a product does not depend on its method of production - MPEP 2113*).

Re claim 12, the combination of Murakami and Kim discloses said adapter having an actuator button part (Kim; Fig. 1 – push button 53) connected to said switch.

Re claim 13, the combination of Murakami and Kim discloses said hand knob having an opening for access to said actuator button (Kim; Fig. 1).

Re claim 14, the combination of Murakami and Kim discloses said actuator button part also comprising a switch display part (Kim; Fig. 1 or 2 – top surface of push button 53).

4. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Tucker (USP 7,032,074).** The combination of Murakami and Kim as modified discloses all of the limitations set forth in claim 1, but fails to disclose wherein said adapter is fastened to said lever via a screw connection

Tucker teaches an adapter (See Fig. 2) fastened to a lever via a screw connection that provides a serviceable shift device assembly for fastening at a selector lever.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined device of Murakami and Kim as modified to include an adapter fastened to said lever via a screw connection, as taught by Tucker, for the purpose of providing a serviceable shift device assembly.

5. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Nedachi (USP 5,588,329).** The combination of Murakami and Kim as modified discloses all of the limitations set forth in claim 1, but fails to disclose wherein said adapter is fastened to said lever via a clip connection

Nedachi teaches (Fig. 1) an adapter (2) fastened to a lever (1) via a clip connection that provides a quick and reliable connection that reduces assembly time.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined device of Murakami and Kim as modified to include an adapter fastened to said lever via a clip connection, as taught by Nedachi, for the purpose of providing a quick and reliable connection that reduces assembly time.

6. **Claims 15 and 17 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.** Murakami discloses (Fig. 1) all of the limitations of a similar device comprising:

- A support structure (not shown, but inherent to figure).
- A selector lever (24) comprising an upper selector lever portion and a lower selector lever portion, said lower selector lever portion being connected to said support structure (not shown, but inherent to figure).
- A connection cable (Fig. 6 – element 15).
- An adapter (Fig. 6 – element 9) mounted to said upper selector lever portion of said selector lever.
- Said adapter having an adapter outer side surface, said adapter outer surface defining a recess (Fig. 6 - 9d),
- Said connection cable being located within said recess, wherein said connection cable is located adjacent to said outer surface of said adapter (Fig. 6).
- A hand knob (element 1 with constituent parts 4 and 5) forming a gripping surface.

- Said adapter defining a connection between said upper selector lever portion of said selector lever and said hand knob (Fig. 5A).
- Said adapter being connected to said hand knob.
- The diameter of the selector lever and the adapter is smaller than a shift gap defined by side edges of a shift gate (26).

Murakami fails to disclose said adapter having an integrated switch.

Kim (see Fig. 1 – 3), in a similar device, teaches an adapter (41) having an integrated switch (assembly 50, 54) that reduces the assembly complexity, thereby improving serviceability over knobs with integrated switches.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Murakami to include an adapter having an integrated switch, as taught by Kim, for the purpose of reducing assembly complexity, thereby improving serviceability.

Accordingly, the combination of Murakami and Kim discloses said integrated switch including a switch interface (Murakami; Fig. 6 - element 16) for said connection cable and a means (Murakami; Fig. 6 – element 6) for transmitting electrical and/or optical signals.

Murakami as modified by Kim fails to disclose said adapter being located at a position above the shift gate.

As the applicant is silent to any unexpected results arriving from said adapter being located at a position above the shift gate, it would have been an obvious matter of design choice to have provided such an arrangement with Murakami as modified by Kim

having said adapter being located at a position above the shift gate, and since it appears that the prior art would perform perfectly well gate *(the adapter located above the would not have an impact of the adapter's function, since it merely serves to provide cable routing, positioning and retention assurance)* with said adapter being located at a position above the shift gate.

Re claim 17, the combination of Murakami and Kim as modified discloses said connection cable having a line (Murakami; Fig. 6 – element 6), said line transmitting said electrical and/or optical signals from said transmitting means to said support structure wherein said adapter has at least one recess (Murakami; Fig. 6 - element 9d) in which said line is disposed.

Re claim 18, the combination of Murakami and Kim as modified discloses said adapter having at least one guide element (Murakami; Fig. 6 – vertical rib portions dispose between guides 9c) for positioning said hand knob.

Re claim 19, the combination of Murakami and Kim as modified discloses said adapter having a part with at least one of an actuator button part (Kim; Fig. 1 – push button 53) and a switch display part connected to said switch (top surface of push button 53), said adapter having a top outer surface, said top outer surface defining an integrated switch recess, said integrated switch being arranged in said integrated switch recess, said hand knob surrounding said adapter.

Re claim 20, the combination of Murakami and Kim as modified discloses said hand knob having an opening for access to said at least one of an actuator button part and a switch display part (Kim; Fig. 1 or 2 – top surface of push button 53) connected to

said switch, said switch display part being disposed opposite said integrated switch (Kim, Fig. 1 or 2; top surface of push button 53 is arranged opposite button structure on which the top surface is disposed).

7. **Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.** Murakami discloses (Fig. 1) all of the limitations of a similar device comprising:

- A support structure (not shown, but inherent to figure).
- A selector lever (24) having an upper end and a lower end, said lower end being connected to said support structure (not shown, but inherent to figure).
- A connection cable (Fig. 6 – element 15) having one or more lines.
- An adapter (Fig. 6 – element 9) mounted to said upper end of said selector lever, said adapter having a top outer surface.
- Said adapter having an adapter outer side surface, said adapter outer side surface defining a recess (Fig. 6 – recess 9d), said one or more lines (6) being located within said recess.
- Said one or more lines being located adjacent to said adapter outer side surface (Fig. 6).
- A hand knob (element 1 with constituent parts 4 and 5) forming a gripping surface.
- Said adapter defining a connection between said selector lever and said hand knob, said hand knob surrounding said adapter (Fig. 5A).

- The diameter of the selector lever and the adapter is smaller than a shift gap defined by side edges of a shift gate whereby the shift gate is passed over said selector lever and said adapter, said hand knob being arranged on said adapter.

Murakami fails to disclose said adapter having a top outer surface defining an integrated switch recess, wherein said adapter has an integrated switch arranged in said recess.

Kim (see Fig. 1 – 3), in a similar device, teaches an adapter (41) a top outer surface defining an integrated switch recess, wherein said adapter has an integrated switch (assembly 50, 54) arranged in said recess that reduces the assembly complexity, thereby improving serviceability over knobs with integrated switches.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Murakami to include a top outer surface defining an integrated switch recess, wherein said adapter has an integrated switch arranged in said recess, as taught by Kim, for the purpose of reducing assembly complexity, thereby improving serviceability.

Accordingly, the combination of Murakami and Kim as modified discloses said integrated switch including a switch interface (Murakami; Fig. 6 - element 16); and said one or more lines being connected to said switch interface (Murakami; Fig. 6).

Response to Arguments

Applicant's arguments filed October 30, 2009 have been fully considered but they are not persuasive. Refer the above rejection in sections 3, 6 and 7 for the Examiner's response.

Conclusion

This is a continuation of applicant's earlier Application No. 10/595502. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILLIP JOHNSON whose telephone number is (571)270-5216. The examiner can normally be reached on MON - FRI, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phillip Johnson/
Examiner, Art Unit 3656

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3656